

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	86743968
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 106
<b>MARK SECTION</b>	
<b>MARK</b>	http://tmng-al.uspto.gov/resting2/api/img/86743968/large
<b>LITERAL ELEMENT</b>	RISKINSIGHTCONNECT
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ARGUMENT(S)</b>	
<p>Applicant believes that the subject application should be accepted for registration. The marks in Reg. Nos. 4632791 and 4632792, PAYNET RISK INSIGHT SUITE and RISK INSIGHT SUITE, respectively, identify website services for analyzing and managing lending risks. Those services are dissimilar to Applicant's online software that compiles, stores, shares, and analyzes data for financial and business risk management purposes specifically relating to man-made and natural catastrophes. The respective services target different classes of consumers, and those consumers are discerning and discriminating consumers who exercise a high level of care in their purchasing decisions. The channels of trade for the respective services are different. Moreover, the elements "PAYNET" and "SUITE" in the cited registered marks and the element "CONNECT" in the applied-for mark differentiate the marks and make confusion even more unlikely. In support the above assertions, Applicant submits a Trademark Consent Agreement entered into between Applicant and Knowledge Works, Inc., the owner of Reg. Nos. 4632791 and 4632792. The Agreement sets forth detailed reasons as to why Applicant and Knowledge Works, Inc. agree that confusion between the marks at issue is unlikely. Moreover, Applicant's entry of a consent agreement negates any presumption that doubts as to likelihood of confusion should be resolved in favor of the cited registrant. In re Donnay International Societe Anonyme, 31 USPQ2d 1953 (TTAB 1994). In view of the above comments and the Trademark Consent Agreement submitted herewith, Applicant respectfully requests that this application be accepted and approved for publication.</p>	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_741182558-20160815111658158100_.KCC-KW_Trademark_Consent_Agreement.pdf</a>
<b>CONVERTED PDF FILE(S)</b> (7 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\867\439\86743968\xml11\RFR0002.JPG</a>
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<b>DESCRIPTION OF EVIDENCE FILE</b>	Trademark Consent Agreement
<b>SIGNATURE SECTION</b>	

RESPONSE SIGNATURE	/PJC/
SIGNATORY'S NAME	Patrick J. Concannon
SIGNATORY'S POSITION	Attorney of record, Massachusetts bar member
DATE SIGNED	08/15/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Mon Aug 15 11:47:45 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XX.XX-20 160815114745426146-867439 68-550c28ce712ceb5c9ed1fc 5d1e6d97191b908b3280b5528 bca2a076cb5de1be85-N/A-N/ A-20160815111658158100

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

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### To the Commissioner for Trademarks:

Application serial no. **86743968** RISKINSIGHTCONNECT(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86743968/large>) has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Applicant believes that the subject application should be accepted for registration. The marks in Reg. Nos. 4632791 and 4632792, PAYNET RISK INSIGHT SUITE and RISK INSIGHT SUITE, respectively, identify website services for analyzing and managing lending risks. Those services are dissimilar to Applicant's online software that compiles, stores, shares, and analyzes data for financial and business risk management purposes specifically relating to man-made and natural catastrophes. The respective services target different classes of consumers, and those consumers are discerning and discriminating consumers who exercise a high level of care in their purchasing decisions. The channels of trade for the respective services are different. Moreover, the elements "PAYNET" and "SUITE" in the cited registered marks and the element "CONNECT" in the applied-for mark differentiate the marks and make confusion even more unlikely. In support the above assertions, Applicant submits a Trademark Consent Agreement entered into between Applicant and Knowledge Works, Inc., the owner of Reg. Nos. 4632791 and 4632792. The Agreement sets forth detailed reasons as to why Applicant and Knowledge Works, Inc. agree that confusion between the marks at issue is unlikely. Moreover, Applicant's entry of a consent agreement negates any presumption that doubts as to likelihood of confusion should be resolved in favor of the cited registrant. In re Donnay International Societe Anonyme, 31 USPQ2d 1953 (TTAB 1994). In view of the above comments and the Trademark Consent Agreement submitted herewith, Applicant respectfully requests that this application be accepted and approved for publication.

### EVIDENCE

Evidence in the nature of Trademark Consent Agreement has been attached.

#### Original PDF file:

[evi\\_741182558-20160815111658158100\\_-\\_KCC-KW\\_Trademark\\_Consent\\_Agreement.pdf](#)

#### Converted PDF file(s) ( 7 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /PJC/ Date: 08/15/2016

Signatory's Name: Patrick J. Concannon

Signatory's Position: Attorney of record, Massachusetts bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86743968

Internet Transmission Date: Mon Aug 15 11:47:45 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XX.XX-20160815114745426

146-86743968-550c28ce712ceb5c9ed1fc5d1e6

d97191b908b3280b5528bca2a076cb5de1be85-N

/A-N/A-20160815111658158100

### Trademark Consent Agreement

This Trademark Consent Agreement ("**Agreement**") is between Karen Clark & Company, a Delaware corporation with its principal address at 10 St. James Avenue, Boston, Massachusetts 02116 ("**KCC**") and Knowledge Works, Inc., a Delaware corporation with its principal address at 5750 Old Orchard Road, #300, Skokie, Illinois 60077 ("**KW**") (each of the above individually a "**Party**" and collectively the "**Parties**").

WHEREAS, KW owns U.S. Trademark Registration No. 4632792 for Risk Insight Suite and U.S. Trademark Registration No. 4632791 for PayNet Risk Insight Suite (the "**KW Registrations**"), each covering "providing a website on the Internet for analyzing and managing lending risks" (the "**KW Services**");

WHEREAS, KCC owns U.S. Trademark Registration No. 3871138 for RiskInsight ("**KCC Registration**"); pending U.S. Trademark Application No. 86/656707 for RiskInsight, pending U.S. Trademark Application No. 86/743968 for RiskInsightConnect, and pending U.S. Trademark Application No. 86/744025 for RiskInsightExpert, which collectively cover the goods and services set forth at Exhibit A to this Agreement (the "**KCC Goods & Services**");

WHEREAS, the U.S. Patent and Trademark Office has provisionally refused registration of KCC's Application No. 86/656707 for RiskInsight and Application No. 86/743968 for RiskInsightConnect based upon an alleged likelihood of confusion with the KW Registrations;

WHEREAS, KCC and KW believe that KCC's and KW's use of their respective marks comprised of or including the element "Risk Insight" (as one word or two) in relation to the KCC Goods & Services and the KW Services, respectively, does not and will not create actual or likely confusion.

NOW, THEREFORE, in consideration of the mutual covenants, agreements and understandings hereinafter contained, and for other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the Parties agree as follows:

1. The Parties believe that consumer confusion between their respective use of marks that are comprised of the element "Risk Insight" (as one word or two), and particularly between KW's Risk Insight Suite and PayNet Risk Insight Suite and KCC's RiskInsight and RiskInsightConnect, is unlikely for the following reasons:
  - a. Consumers of the Parties' respective goods and services are discerning and discriminating consumers who exercise care in their purchasing decisions and are likely to recognize that the goods and services identified by the respective marks come from different sources;
  - b. The channels of trade for the Parties' respective goods and services are different;
  - c. The KW Services, and particularly those listed in Reg. Nos. 4632792 and 4632791, which involve providing information for analyzing and managing lending risks, and the KCC Goods & Services, and particularly those listed in

Appl. Nos. 86/656707 and 86/743968, which involve compiling, storing, sharing and analyzing risks relating to man-made and natural catastrophes, are sufficiently dissimilar; and

d. The respective marks are sufficiently dissimilar in their appearance, sound, meaning, and commercial impression.

2. The Parties agree that there is no conflict or likelihood of confusion as to source, origin or sponsorship between their use of marks that are comprised of the element "Risk Insight" in relation to the KW Services and the KCC Goods & Services, and particularly between KW's Risk Insight Suite (in Reg. No. 4632792) and PayNet Risk Insight Suite (in Reg. No. 4632791) and KCC's RiskInsight (in Appl. No. 86/656707) and RiskInsightConnect (in Appl. No. 86/743968). The Parties further agree that the phrase "risks relating to man-made and natural catastrophes" used in the KCC Goods & Services shall have the meaning set forth by KCC in the application that matured into the KCC Registration.

3. Accordingly, (a) KW hereby consents to KCC's use of and registration of KCC's RiskInsight (in Appl. No. 86/656707) and RiskInsightConnect (in Appl. No. 86/743968); and (b) KCC hereby consents to KW's use and registration of Risk Insight Suite (Reg. No. 4632792) and PayNet Risk Insight Suite (Reg. No. 4632791).

4. The Parties agree to cooperate and consult with one another, in good faith, should future conditions or developments suggest to either the possibility that the Parties' respective marks might be likely to be confused with one another, all with the view to ensuring that no substantial likelihood of confusion between the Parties' respective marks shall occur.

5. Either Party may each apply for federal, state, or foreign trademark registration of their respective marks that include the element "Risk Insight," and neither Party shall oppose such an application of the other, take action to cancel any resulting registration, or otherwise seek to limit or restrain the other's rights to use and/or register said marks, so long as such applications seek registration of marks in relation to the KCC Goods & Services or the KW Services, as appropriate.

6. Nothing herein shall be construed to constitute the Parties hereto as acting in partnership or in joint venture or as any Party acting as the agent of the other. Neither Party will attempt to associate itself with the other Party.

7. Should KCC legally abandon its marks that include the element "RiskInsight" or should KW legally abandon its marks that include the element "Risk Insight," such abandoning Party's rights shall be lost and the other Party may thereafter use its mark in all proper ways, unrestrained by the terms of the Agreement, and may thereafter apply for and obtain a federal, state and/or foreign registration of its mark(s) unrestricted by this Agreement.

8. Either Party may license or assign its respective rights hereunder, in whole or in part, provided that such license or assignment does not expand or modify this Agreement.

9. The Parties agree that nothing herein is intended to in any way restrict the other Party.

10. Rather, the Parties recognize that it is in their respective best interests to conduct their practices under their respective marks in such fashion so as to continue to avoid any likelihood of confusion, deception or mistake.

11. This Agreement and Exhibit A attached hereto collectively embody the entire understanding of the Parties and shall supersede all prior oral and written agreements or understandings between the Parties relating to the subject matter hereof. This Agreement may not hereafter be modified except in a writing signed by both Parties hereto. Any term or provision of this Agreement that is invalid or unenforceable in any jurisdiction shall, as to such jurisdiction, be ineffective to the extent of such invalidity or unenforceability without rendering invalid or unenforceable the remaining terms and provisions of this Agreement, or any such terms in any other jurisdiction. If any provision of this Agreement is so broad as to be unenforceable, such provision shall be interpreted to be only so broad as is enforceable.

12. This Agreement shall be binding on the Parties, their subsidiaries, successors, assigns, heirs, employees, trustees, agents, or those acting in concert with them or under their direction and control.

13. This Agreement shall come into force and be effective on the day the last Party executes this Agreement.

14. The Parties agree that each shall bear it own costs in relation to this Agreement and its subject matter.

15. The signatory on behalf of each Party warrants that he/she has authority to execute this Agreement on behalf of that Party and thereby bind such Party to this Agreement.

16. This Agreement may be executed in counterparts and by the Parties to it on separate counterparts, each of which when so executed and delivered shall be an original, but all the counterparts shall together constitute one and the same instrument. A signed copy of this Agreement delivered by facsimile, e-mail or other means of electronic transmission shall be deemed to have the same legal effect as delivery of an original signed copy of this Agreement.

*[Signature page follows]*

IN WITNESS WHEREOF, the Parties hereto have caused this Agreement to be executed by their duly authorized officers as of the day, month and year first hereinabove written.

Dated: August \_\_, 2016

KAREN CLARK & COMPANY

By \_\_\_\_\_  
Name:  
Title:

Dated: August 9, 2016

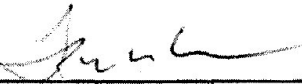
KNOWLEDGE WORKS, INC.

By \_\_\_\_\_  
Name: T. DOUGLAS CLEVELAND  
Title: V.P. MARKETING

executed by their duly authorized officers as of the day, month and year first hereinabove written.


Dated: August 17, 2016

KAREN CLARK & COMPANY

By   
Name: Karen Clark  
Title: President and CEO

Dated: August 9, 2016

KNOWLEDGE WORKS, INC.

By   
Name: T. Douglas Cleveland  
Title: V.P. Marketing

## **Exhibit A**

### **The KCC Goods & Services**

#### **Trademark Registration No. 3871138 for RiskInsight**

Class 9: Software for compiling, storing, sharing and analyzing data for financial and business risk management purposes, namely, risks relating to man-made and natural catastrophes.

#### **Trademark Application No. 86/656707 for RiskInsight**

Class 42: Software as a service (SAAS) featuring software for compiling, storing, sharing, and analyzing data for financial and business risk management purposes, namely, risks relating to man-made and natural catastrophes.

#### **Trademark Application No. 86/743968 for RiskInsightConnect**

Class 35: Business risk assessment services relating to risks stemming from man-made and natural catastrophes; Business risk management consultation relating to risks stemming from man-made and natural catastrophes; Providing a web-based online portal which provides access to risk management information, namely, risk information relating to man-made and natural catastrophes, man-made and natural catastrophe risk models, risk model components, and risk data; Providing a web-based online portal in the field of risk management which provides user access to risk management professionals, scientists, engineers, academics and private consultants, as well as data, commentary, information and content relating to man-made and natural catastrophe risk that enables users to develop man-made and natural catastrophe risk models; Providing a web-based online portal that allows users to license and buy materials relating to the modeling of man-made and natural catastrophe risks from risk management professionals, scientists, engineers, academics and private consultants

Class 42: Providing a searchable online computer database featuring information regarding risk management, namely, risk information relating to man-made and natural catastrophes, man-made and natural catastrophe risk models, catastrophe risk model components and catastrophe risk data; Providing a searchable online computer database featuring information about and access to risk management professionals, scientists, engineers, academics and private consultants and data, commentary, information and content about catastrophe risk management, man-made and natural catastrophe risk modeling; Providing software as a service (SAAS) featuring software for compiling, storing, sharing, and analyzing data for risk management purposes, namely, risks relating to man-made and natural catastrophes

#### **Trademark Application No. 86/744025 for RiskInsightExpert**

Class 35: Providing a web-based online portal in the field of risk management for purposes of risk management consultation and risk management research purposes which provides users access to natural and man-made disaster risk management professionals, scientists, engineers, academics and private consultants, as well as data, commentary, information and content relating to man-made and natural catastrophe risk that enables users to develop man-made and natural catastrophe risk models

Class 42: Providing software as a service (SAAS) featuring software for compiling, storing, sharing, and analyzing data for risk management purposes, namely, risks relating to man-made and natural catastrophes

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